

No. 11,769

IN THE

United States Circuit Court of Appeals  
For the Ninth Circuit

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ACHILLE BIANCHI and MARLO PACKING  
CORPORATION,

*Defendants-Appellants,*

vs.

ARTHUR E. H. BARILI,

*Plaintiff-Appellee.*

ARTHUR E. H. BARILI,

*Plaintiff-Appellant,*

vs.

ACHILLE BIANCHI and MARLO PACKING  
CORPORATION,

*Defendants-Appellees.*

BRIEF FOR DEFENDANTS-APPELLANTS.

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**BRIEF FOR DEFENDANTS-APPELLANTS.**

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**STATEMENT OF THE CASE.**

This is a patent infringement suit involving the infringement of claim 4 of the Barili patent No. 1,844,142. The court below found that claim 4 had been infringed. Defendant-appellant Bianchi is the manu-

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(NOTE) : All italics supplied.

facturer of the accused ravioli making machine, and the other defendant-appellant, Marlo Packing Corporation is the user thereof. The questions involved are first, is claim 4 valid, and second, does the accused machine infringe this claim. An appeal is also taken by plaintiff-appellant with respect to the lower court's failure to award damages and attorney fees, and the ordering of the case to trial the day after an order had been entered setting aside a prior judgment in this case in favor of defendants-appellants.

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**ERRORS RELIED ON AND STATEMENT OF ISSUES.**

The defendants-appellants challenge the correctness of findings 1, 2, and 3 (R. p. 24), and contend that the application of the controlling law does not warrant conclusions of law 3, 4, 5, 7 and 8 (R. pp. 25, 26). Findings 1, 2 and 3 state that defendants-appellants have made and used without authority, stuffed pastry machines of the type shown on defendants' exhibit B, and the conclusions of law state that claim 4 has been infringed.

The issues and defendants' contentions may be stated as follows:

1. Claim 4 of the patent in suit is invalid because it is anticipated by the prior art and for the further reason that the drawings and specification of the patent in suit do not support this claim.

2. Claim 4 in issue cannot be "fairly read" upon the accused machine, when considered in the light of

the file history, and in the light of the express terms and limitations of the claim, and also in the light of the prior art.

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### ARGUMENT.

#### EXPLANATION OF THE BARILI PATENT IN SUIT.

The Barili patent in suit (plaintiffs' exhibit 1) relates to a machine for making stuffed pastry, such as ravioli or filled confectionery. (Barili patent p. 1, lines 2, 3.) More particularly the patented machine comprises two rollers rotatable in opposite directions, one having indented molds and axial cutters between the molds and the other having annular cutters. The only claim in issue here reads as follows:

4. In a ravioli machine, a pair of intergearing rollers, one roller having indented molds and provided with axial cutters between said molds, the other roller being made with annular peripheral cutters adapted to be positioned between the molds of the first named roller at the point of contact of the rollers, all the molds being spaced apart so as to provide a wide margin between the cutters and the molds, means for feeding sheets of flour paste to the rollers, and a detachable open bottom hopper for guiding stuffing to the paste sheets on the rollers.

## DEFENDANTS' ACCUSED MACHINE.

Defendants' machine (Defendants' Exhibit B) was the only structure before the Court. There was a rather vague attempt by plaintiff to show that defendant Bianchi manufactured another machine, but there is no adequate proof of its detailed construction nor of its date of manufacture. In fact, the uncontradicted testimony of defendant Bianchi is that he had not made any ravioli machine during the past six years (R. p. 99). There is no testimony or other evidence showing that the defendant, Marlo Packing Corporation, used either the machine shown on defendants' exhibit B or any other type of ravioli machine during the six year period preceding the filing of the complaint.

The lower court considered only defendants' exhibit B when passing on the question of infringement, and no doubt it will become apparent to this court that the only properly identified alleged infringing structure is the one shown on the large set of photographs, defendants' exhibit B.

Defendants' machine comprises two large rollers, one having a plurality of indented molds and the other carrying a number of spaced annular cutters and also a plurality of so-called axial cutters. The rollers are spaced one from the other and they are arranged to rotate in opposite directions. Two sheets of dough are conveyed between the rollers, and a stuffing material supplied from a hopper above is fed between the sheets. The stuffing material is pressed into the molds



between the sheets as the rollers rotate, thereby forming pieces of stuffed pastry, such as ravioli.

It is to be noted that unlike the structure defined by claim 4 defendants' accused machine includes one roller having molds but *no* cutters, while the other roller carries both sets of annular and axial cutters.

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**CLAIM 4 IS INVALID.**

Under this heading it will be pointed out that claim 4 in suit is fully anticipated by the prior art and is utterly invalid.

This claim is also invalid because of its failure to read on the disclosures in the patent specification and drawings, or in other words, because the patent specification and drawings do not support the claim.

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**PRIOR ART ANTICIPATES CLAIM 4.**

The Holmes patent No. 518,454, dated April 17, 1894 (Defendants' Exhibit D), discloses a machine for forming stuffed articles of pastry or confectionery. It includes:

1. Two pairs of rollers d,d which act to feed the paste or dough forward and also to form it into two sheets of desired thickness (p. 2, lines 1-5 Holmes patent);

2. Rollers e,e for forming and uniting the sheets. These rollers are formed with annular grooves which

are semi-circular in cross section. The Holmes patent describes the operation of these forming and uniting rollers (p. 2, lines 63-70) as follows: "The two sets of shaped semi-forms of paste are carried toward each other upon the rollers e, and at the point where the two rollers e come in contact with each other the edges of the semi-tubes are brought into adhesive contact with the edges of the opposite semi-forms and these edges unite and thus complete tubes are formed." Holmes shows in Figure 11 an arrangement on a roller e for cutting the product into suitable lengths. This structure is described on page 3, lines 107-114 as follows: "When the articles to be produced are of short lengths I sometimes cut or separate them into lengths by projections within the grooves of the rollers e. Such construction is shown in Figure 11 and the projections are there lettered X.";

3. A hopper or filling device i is positioned to feed a stuffing material between the paste sheets as they pass over the rollers e,e. The hopper i is adjustable and is supported on the machine's frame.

It is to be noted that Holmes (p. 3, lines 99-107) contemplates the use of the rollers e,e independently of the auxiliary rollers h, it being stated that "the sheets of dough will then pass directly over these forming and uniting rollers and down between them, and the shaping and uniting of the parts will take place simultaneously as the paste is fed between the rollers."

*Evans* No. 1,094,320, dated April 21, 1914 (Defendants' Exhibit E) shows two oppositely rotatable rollers,

one having *annular cutters* d, and the other "*axial*" *cutters* c. As the rollers are rotated and the dough is fed downwardly therebetween, the cutters d and c operate to cut the dough into squares.

*Oleri* No. 1,479,925, dated Jan. 8, 1924 (Defendants' exhibit F), was not one of the references cited by the patent office examiner during the prosecution of the Barili patent application. This patent is of considerable importance since it shows a roller having "*axial*" cutters and annular cutters with *wide margins* between the cutters and the molds for *sealing* the edges of the ravioli.

The *Tomassini* patent No. 1,236,998, dated Aug. 14, 1917 (Defendants' Exhibit G), and the *Raviolara pamphlet* obtained by defendant Bianchi in Europe in 1919 (Defendants' Exhibit A) were introduced into the record at the trial of the case to show that automatic ravioli manufacturing machines were in use long prior to the filing of the patent application which resulted in the patent in suit.

The Holmes and Evans patents disclose all of the elements of claim 4. In Holmes is found the forming and uniting rollers e,e, which correspond to and function in the manner of the rollers 11 and 12 of the patent in suit. The rollers e,e of Holmes have semi-circular grooves which permit the stuffing material to be fed between the sheets of dough as the latter are united to form sealed envelopes. Holmes shows wide annular ridges between the circular grooves which press the paste sheets together and unite them

so as to retain the stuffing material within the paste envelopes. The sealing of the paste sheets is described by Holmes (p. 1, lines 32-42) as follows:

“When my entire invention is used, filling devices are arranged and operated to feed suitable filling substance to and between the portions or sheets as they are brought together; and the pressure devices then cause the portions to unite; or when the articles are to consist of an envelope of hollow form and a filling substance, *the pressure devices cause the edges of the portions to unite*”;

and on page 2 lines 65-70 Holmes further states:

“at the point where the two rollers e,e come in contact with each other the edges of the semi-tubes or forms are brought into adhesive contact with the edges of the opposite semi-forms, and these edges unite and thus complete tubes are formed.”

The very purpose of the Holmes rollers e,e is to form the paste sheets and *unite* them in a manner whereby the stuffing material is held therebetween. Claim 4 of the patent in suit states that the molds are spaced apart to provide wide marginal flanges, but in Holmes there is also found *wide marginal flanges* between the annular molds or grooves of rollers e,e which also unite and seal the paste sheets.

*Evans* shows annular cutters d and “axial” cutters e which correspond to the annular and axial cutters of the patent in suit.

In ravioli making it has been the common practice for many years before the filing of the Barili patent application in 1927, to unite two paste sheets with stuffing material between by means of a roller having peripheral molds and cutters with wide margins between the cutters and the molds. Oleri, No. 1,479,925 clearly shows such a device. Both Holmes and Oleri anticipate the feature of claim 4, which includes wide marginal flanges between the cutters and the molds.

Claim 4 is fully anticipated by Holmes, Evans and Oleri. "A pair of intergearing rollers" are shown at e,e, in Holmes; the "axial and annular cutters" are shown in Evans at c and d; Oleri shows "wide margins" between the cutters and the molds for uniting the paste sheets and sealing the edges of the ravioli; Holmes also shows "wide margins" between the molds for uniting the sheets of paste; Holmes shows "means for feeding sheets of paste to the rollers" and "a detachable open bottom hopper i for guiding stuffing to the paste sheets on the rollers."

The fact that plaintiff's machine is designed to manufacture a type of stuffed pastry which is different in size and shape from that made by the Holmes machine, does not lend patentability to the Barili invention. A change in form, proportion or degree, doing substantially the same thing in substantially the same way by substantially the same means—is not patentable novelty.

It is apparent that the following quotations from certain United States Supreme Court decisions are applicable here.

*Penn-Railroad v. Locomotive Truck*, 110 U. S. 490, 28 L. Ed. 222:

“It is settled by many decisions of this court which it is unnecessary to quote from or to refer to in detail, that the application of an old process or machine to a similar or analogous subject, with no change in the manner of application, and no result substantially distinct in its nature, will not sustain a patent, even if the new form or result has not before been contemplated.”

*Butler v. Steckel*, 137 U. S. 21, 34 L. Ed. 582:  
 “In view of the testimony as to the state of the art it required no invention to make a single die to cut dough on a flat surface, into any particular shape desired whether the shape of a pretzel or any other shape. The question was one, not of invention, but simply of mechanical skill.”

*Burt v. Ivory*, 133 U. S. 349:

“A mere carrying forward of the original thought, a change in form, proportion or degree, doing the same thing in the same way, by substantially the same means, with better results, is not such an invention as will sustain a patent.”

*Heald v. Rice*, 104 U.S. 737, 26 L. Ed. 910:

“The courts are guardians of the public interest and it is their duty to scrutinize with care every

attempt to establish a monopoly which a patent gives. The law does not allow mere mechanical skill to usurp the place of invention which involves higher thought, and brings different faculties into activity. It will not allow one to take from the public that which the public already has, or grant the exclusive privilege which the patent confers without consideration.”

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#### ARGUMENT RE FILE HISTORY.

The fourteen original claims in the Barili patent application were rejected on the Holmes patent No. 518,454. (Defendants' Exhibit C, pages 10-13.) These claims were extensively amended (Defendants' Exhibit C, pages 18-20), but a second rejection resulted. Then followed the submitting of an entirely new set of claims, numbered 15 to 26. (R. 158-161.) Holmes and the Evans patent No. 1,094,320 were cited against certain of the claims (R. 163), and their rejection followed. Barili then extensively amended the claims (R. 165-172), but they were again rejected (Defendants' Exhibit C, pages 34, 35) on these same references, it still being contended by the examiner that it did not amount to invention to make the Holmes device, in the manner taught by Evans, with one roller carrying annular cutters and the other roller carrying axial cutters. The examiner's rejection (Defendants' Exhibit C, page 34) in part is as follows:

“It is again indicated that (see Fig. 4 of Evans) the elements d are the annular cutters on one roller, while the elements c are the axial cut-

ters on the other roller which fit between the annular cutters of the former. These rollers 4 and 7 could readily be substituted for the rollers e, e of Holmes' machine."

In the same official letter the examiner dismissed applicant's contention that the hopper embodied invention by stating:

"It is the opinion of the examiner that an artist at the trade could readily adapt the hopper of Holmes to be used for dispensing ravioli in that if it was seen that the filling material was not feeding properly a large aperture could be made in the bottom."

So up to this point during the prosecution of the Barili application we see the examiner has ruled that it was not patentably novel to provide two rollers with annular and axial cutters, and that it did not amount to invention to provide a hopper having an edge conforming to the contour of the rollers. It is also to be noted that the examiner *did not reverse his decision with respect to these two points at any subsequent time.*

The next development in the prosecution of the application was applicant's cancellation of the claims (with the exception of claim 26, now claim 1 which defined a roller made in sections, and which was probably new in the art), and the *substitution of claims which were limited to a combination in which there were broad peripheral margins between the cutters and the molds.* While the Holmes patent clearly shows peripheral means for uniting the two dough sheets



and sealing their edges, the examiner probably thought there was not a full disclosure of the "*wide margin between the cutters and the molds.*" The fact of the matter is, however, Holmes *does* show means carried by his rollers for uniting, cutting and sealing the edges of two sheets of dough so the stuffing therebetween cannot escape. It therefore would not be inventive to make the peripheral margins a bit wider, for such a change is a matter of degree and is not patentable.

*But at this point it is to be noted that the examiner entirely overlooked the Oleri Patent No. 1,479,925 issued Jan. 8, 1924. (Defendants' Exhibit F.)* The device shown in this patent is used for manufacturing ravioli. It *shows, molds and the arrangement of axial and annular cutters between the molds.* There is also *shown wide margins between the cutters and the molds which press the two paste sheets together, and unite them while the cutters cut the material into squares.* Here we see a device which simultaneously forms, seals and cuts the ravioli material. Had the examiner this Oleri patent before him, he undoubtedly would have rejected all of the claims (Except claim 1), for in Holmes we see at e,e the two forming, uniting and cutting rollers, at i the hopper for delivering a stuffing material to the dough sheets while they are passing over e,e; in Evans we see the two rollers with the axial and annular cutters; and in Oleri we see a roller with peripheral molds, annular and axial cutters, and wide margins between the cutters and the molds for uniting and sealing the paste sheets.

It is therefore obvious that claim 4 is directly met by the prior art and is invalid.

Presumption of validity of a patent grant is eliminated where the patent examiner fails to find a prior disclosure, discovery of which would have rendered the issuance of the patent doubtful. Judge Learned Hand in *Hoe v. Goss*, 30 F. (2d) 271, 284 stated:

“Moreover we are not faced with the presumption of validity in this respect because of the examiner’s failure to find Galley as a reference; it is at least open to doubt whether, had Galley been discovered, the claims would have been issued.”

The slight modification made in the Holmes, Evans and Oleri disclosures by Barili did not amount to invention. The test as to what constitutes patentable invention is stated in *Altoona Public Theaters v. American Tri-Ergon Corp.*, 294 U.S. 484 at 486 as follows:

“The patentees brought together old elements, in a mechanism involving no new principle, to produce an old result, greater uniformity of motion. However skillful this was done, and even though there was produced a machine of greater precision and a higher degree of motion consistency and hence one more useful in the art, it still was the product of skill and not invention.”

**CLAIM 4 INVALID BECAUSE DISCLOSURE DOES NOT  
SUPPORT IT.**

Claim 4 is also invalid for still another reason. The terms of this claim specify that the cutters are adapted to be positioned between the molds “*at the point of contact of the rollers.*” It will be noted that both the patent drawings and the specification clearly show and describe the rollers as being spaced apart. In fact they must be in spaced relation since the cutters project therefrom, otherwise, the rollers could not rotate.

A claim which improperly describes the relationship of the elements of a claimed combination is invalid. Claim 4 is fatally defective since it is not supported by the disclosure.

*In re Adams*, 117 F. (2d) 1017, 1018, a Court of Customs and Patent Appeals case, gives the rule here applicable as follows:

“It is elementary that appellant’s disclosure must support the claims, and that where positive limitations are set out in the claims he may not rely on other patents or knowledge of those skilled in the art to supply those omissions in his own disclosure \* \* \* To now read into his application, by implication a description of the limitations set out in the claims would be in violation of well established rules of patent law. It is too clear for argument that appellant’s disclosure does not support the claims before us.”

To the same effect:

*Atherton v. Payne*, 54 F. (2d) 821;

*In re Salomon*, 136 F. (2d) 728;

*In re MacFarren*, 121 F. (2d) 468.

## NON-INFRINGEMENT.

As a preliminary, the Court will appreciate the fact that the protection furnished by a patent is measured by what is set forth in the claims, and that the patentee is bound by the limitations set forth therein. (*Minerals Separation Ltd. v. Butte etc. Mining Co.*, 250 U.S. 336.) Claims are narrowly construed when, as here the patent in suit is a mere improvement patent. (*Wilson Mfg. Co. v. Niedringhaus*, 28 F. (2d) 766.)

It will be noted that the Barili invention is not a pioneer in the art of manufacturing stuffed pastry. The Holmes patent No. 518,454, previously discussed herein, discloses an automatic machine for producing stuffed pastry. The Tomassini patent No. 1,236,998, issued in 1917 and the Raviolara pamphlet (Defendants' Exhibit A) published prior to 1919, show automatic ravioli machines. In fact it was frankly admitted by Barili when his application for patent was pending in the Patent Office that he was not the first to devise a ravioli machine. The file history at page 37 (R. p. 174) discloses that Barili made the following frank admission:

“Applicant is not the first to devise a ravioli machine. Reference is invited to Tomassini, 1,236,998, August 14, 1917. This machine is used in various parts of the country. . . .”

Plaintiff cannot resort to the doctrine of equivalents to give Claim 4 a broad interpretation for two reasons: (1) because of the state of the prior art, and (2)

because of the limitations inserted during the prosecution of the application in the Patent Office.

A definition of a pioneer invention is stated in 48 Corpus Juris at page 228 as follows:

“A pioneer invention is commonly understood to denote a patent covering a function never before performed, a wholly novel device, or one of such novelty and importance as to mark a distinct step in the process of the art, as distinguished from a mere improvement or perfection of what has gone before.”

Most conspicuous examples of such pioneer patents are those granted to Howe for the sewing machine, to Morse for the electric telegraph, and to Bell for the telephone.

What is *not* a pioneer invention is stated in 48 Corpus Juris page 228 as follows:

“An invention which does not perform a function that was never performed by an earlier invention but merely performs its function in a substantially different way is not a ‘pioneer invention’ and the patent therefor is a secondary patent.”

It is to be noted therefore, that the patent in suit is not a pioneer, but merely a secondary or improvement patent, and one which is susceptible of but a narrow construction. The rule here applicable with respect to the interpretation and construction of claim 4 is stated in *Duff v. Sterling Pump Co.*, 107 U.S. 636, 27 L.Ed. 517 as follows:

“The case is one where, in view of the state of the art, the invention must be restricted to the form shown and described by the patentee. In the field of washboards made of metal, with the surfaces broken into protuberances formed on the body of the metal, so as to make a rasping surface and to strengthen the metal by its form and to provide channels for the water to run off. *Todd was not a pioneer. He merely devised a new form to accomplish these results. The defendant adopts another form. Under such circumstances the Todd patent cannot be extended so as to embrace the defendant’s form.*”

The Court below erred in not treating the patent in suit as a secondary or improvement patent, one which is susceptible of but a narrow construction. *The lower court disregarded certain limitations appearing in claim 4, and erroneously held that defendants’ accused machine came within the terms thereof.*

The structure set forth in claim 4 is as follows:

“In a ravioli machine, a pair of intergeared rollers, *one roller having molds and provided with axial cutters between said molds, the other roller being made with annular peripheral cutters adapted to be positioned between the molds of the first named roller at the point of contact of the rollers, all the molds being spaced apart so as to provide a wide margin between the cutters and the molds, means for feeding sheets of flour paste to the rollers, and a detachable open bottom hopper for guiding stuffing to the paste sheets on the rollers.*”

It is to be noted that the claim is limited to a structure wherein there are two rollers, *one having molds and axial cutters, and the other having annular peripheral cutters.*

In defendants' accused machine (Defendants' Exhibit B) *one roller has no cutters whatsoever, only molds; while the other roller has both annular and axial cutters, and no molds.*

Claim 4 is further limited to a structure wherein the rollers are *in contact with one another.* In defendants' machine the rollers are separated appreciably from one another.

Since defendants' machine does not embody the structure set forth in claim 4 there is no infringement thereof. The following decisions set forth the rules applicable here with respect to claim interpretation.

In *White v. Dunbar*, 119 U.S. 21, the rule concerning claim interpretation is stated as follows:

“Some persons seem to suppose that a claim in a patent is like a nose of wax which may be turned and twisted in any direction by merely referring to the specification, so as to make it include something more than, or sometimes different from, what its words express. The claim is a statutory requirement, prescribed for the very purpose of making the patentee define precisely what his invention is; and it is unjust to the public as well as an invasion of the law to construe it in a manner different from the plain import of its terms.”

In *Flowers v. Austin-Western Co.*, 149 F. (2d) 955 the rule here applicable is stated as follows:

“. . . thus it is clear that each of the patents is one of improvement on a combination of elements in prior use. In such a field the claims are not entitled to a broad and liberal construction, but on the contrary, the range of equivalents includes nothing not substantially identical with the means described in the patents, and the use of other known means, although equivalent in function, will be excluded.”

In *McClain v. Ortmyer*, 141 U.S. 419, 35 L. Ed. 800, the Court states as follows:

“The object of the patent law in requiring the patentee to particularly point out and distinctly claim the part, improvement or combination which he claims as his invention or discovery, is not only to secure to him all to which he is entitled, but to appraise the public as to what is still open to them. The claim is the measure of his relief, and while the specification may be referred to limit the claim, it can never be availed to expand it.”

In *DeCew v. Union Bag and Paper Corp.*, 57 F. Supp. 388, 395, the rule is clearly stated as follows:

“The claims, as the measure of the invention, not only define the limits of the patent monopoly but also determine the scope of the art, and these boundaries established by the patentee, may be neither expanded on or shortened to meet the exigency of the particular situation.”



## FILE WRAPPER ESTOPPEL.

There is still another reason why claim 4 must be held to be not infringed, an examination of the file history (Defendants' Exhibit C) discloses at page 40 (R. 177) that claim 29 was submitted after several previous rejections of other claims. This claim specified that one of the rollers had molds with axial cutters between, and that the other roller had annular peripheral cutters positioned between the molds. The examiner rejected the claim on the ground that it was vague. (R. 178.) Applicant Barili then cancelled claim 29 and substituted claim 31 (R. 179), following which the examiner again rejected the substituted claim and required that the limitation "*at the point of contact of the rollers*" be inserted before it could be allowed (R. 180). The applicant then amended the claim by inserting the required limitation (R. 181), and claim 4 resulted.

Now, under well recognized principles in patent law, an applicant by inserting limitations in a claim in order to secure its allowance cannot later in a suit for infringement ignore these limitations and contend that an accused structure not having those limitations infringes. The recent United States Supreme Court case, *Exhibit Supply Co. v. Ace Patents Corporation*, 315 U.S. 126, 136, 86 L.Ed. 736, 744, is directly in point here. The facts are similar to those of the instant case, and the legal principle involved is applicable here. The applicant in the *Ace Patents Case*, by amendment during the prosecution of the application limited claim 7 in order to secure its allowance by inserting

certain limitations as to the location of certain elements of the combination sought to be patented.

The Supreme Court in its decision stated as follows at page 136:

“Had claim 7 been allowed in its original form it would have read upon all of the accused devices since all of the conductor means complementary to the coil spring are ‘carried by the table’. By striking that phrase from the claim and substituting for it ‘imbedded in the table’ the applicant restricted his claim to those combinations in which the conductor means, though carried on the table, is also imbedded in it. *By the amendment he recognized and emphasized the difference between the two phrases and proclaimed his abandonment of all that is embraced in that difference.* (Hubbel v. U.S. 179 U.S. 77.) The difference which he thus disclaimed must be regarded as material, and since the amendment operates as a disclaimer of that difference it must be strictly construed against him. (Smith v. Magic City Kennel Club 282 U.S. 790.) As the question is one of construction of the claim it is immaterial whether the examiner was right or wrong in rejecting the claim as filed (Hubbel v. U.S. Supra). It follows that what the patentee, by strict construction of the claim, has disclaimed—conductors which are carried by the table but not imbedded in it—cannot now be regained by recourse to the doctrine of equivalents which at most operates, by liberal construction to secure to the inventor the full benefits, not disclaimed, of the claims allowed. Plaintiffs exhibits do not infringe.”

By applying the principles set forth in the “Ace patents” case to the case at bar it will be readily seen

that Barili in amending claim 31 (now claim 4) through the insertion of the words "at the point of contact of the rollers" *abandoned any exclusive right to a combination employing rollers which were not in contact*. In other words, anyone has the right to use forming and cutting rollers which are *not in contact* with one another. In defendants' accused machine the rollers are not in contact. On the contrary, the rollers are appreciably separated in defendants' accused machine. Hence claim 4 is not infringed.

The doctrine controlling here is also stated by Judge L. Hand in *Keith v. Charles E. Hires Co. Inc.*, 116 F. (2d) 46, 48, as follows:

"But often even with the most sympathetic interpretation, the claim cannot be made to cover an infringement which in fact steals the very heart of the invention; no matter how auspiciously construed, the language forbids: It is then that the doctrine of equivalents intervenes to disregard the theory that the claim measures the monopoly and ignores the claim in order to protect the real invention. *The estoppel of the file wrapper puts an end to the court's power to do this: the applicant has abandoned his privilege to resort to an equivalent of the differentia*, which all infringements must therefore embody. He may still insist that the claim shall be generously interpreted, but his monopoly stops where the interpretation stops. So, therefore, as, but for the estoppel, Goldring (the patentee) might have been entitled to go beyond the claim there in the case at bar, he lost that privilege as to the element by which that claim differs from the cancelled claims. . . . 'Apertures in the lower portion' cannot be read as a single vertical aperture running from one portion into the portion above it; and

'aperture' cannot be aligned with itself. In such a case it is almost inevitable instinctively to resort to the doctrine of equivalents to escape such verbalism; but that is precisely what the estoppel forbids, as we have said. We hold therefore that the defendant did not infringe claim 3."

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### CONCLUSION.

It is respectfully submitted that claim 4 of the patent in suit is anticipated by the prior art and is invalid; that claim 4 is invalid for the further reason that the patent specification and drawings do not support it; that the patent in suit, being a secondary patent is susceptible of but a narrow interpretation which does not permit the application of the doctrine of equivalents in determining the question of infringement; that defendants' machine does not come within the terms of claim 4 and therefore does not infringe the patent in suit; and that the plaintiff is estopped to assert an interpretation of the claim in issue, which would give sufficient scope to cover the accused machine.

It is our contention therefore, that the judgment and decree of the lower court must be reversed with respect to the holding of infringement and validity of claim 4 of the patent in suit.

Dated, San Francisco, California,  
January 9, 1948.

Respectfully submitted,

J. E. TRABUCCO,

*Attorney for Defendants-Appellants.*

**PLAINTIFF-APPELLANT'S APPEAL.**

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Plaintiff-appellant contends the lower court erred in ordering the case to trial the day following the setting aside of a judgment against him. A review of the proceedings leading up to the setting of the case for trial should indicate that no error was committed.

The attorneys of record for plaintiff-appellant are and have been Alan Franklin of Los Angeles and Messrs. Boyken and Beckley of San Francisco.

On December 2, 1946, the case was originally set for trial, the trial date being Feb. 6, 1947. Notice was previously mailed on Nov. 25, 1946 by the Clerk of the U. S. District Court advising counsel that the case would appear on the law and motion calendar for setting. Only Mr. James Naylor an attorney for one of the defendants' was present on Dec. 2nd, when the case was set for trial. The affidavit of Mr. Beckley states that notice was not received by Mr. Franklin of either the notice fixing the day for the setting or the notice of the trial date; and the clerk's records seem to bear him out in this respect.

Following the setting of the case for trial and prior to the trial date, a motion by defendant-appellant with respect to the taking of depositions was heard by Judge Harris on December 10th, 1946. At this hearing Mr. Beckley was present and represented the plaintiff in opposing the motion. At that time there was some discussion between counsel as to the date of the trial (R. 47). It is thought that even if actual

notice had not been given plaintiff's counsel of the trial of the case, they were at least made aware of the fact that the case had been actually set for trial on Dec. 10th. Mr. Beckley no doubt thought that Mr. Franklin knew of the trial date, but being an attorney of record it was his responsibility to determine the date of the trial after having been informed that the case had been actually set for trial.

On Feb. 6, 1947, the day set for the trial of the case, plaintiff was not present in Court. Upon the examination of defendant Bianchi and the submitting of other evidence showing non-infringement, judgment was rendered in defendants' favor and costs and counsel fees were assessed against plaintiff in the sum of \$500.00.

On March 10, 1947 plaintiff's motion to set aside the judgment and to reset the case for trial was heard. (R. 44-51.) Defendants did not oppose the motion but insisted upon an early trial date. The court thereupon set the case for trial for the following day, March 11, 1947.

The case came on for trial as scheduled at 10 a.m. March 11, 1947. Counsel for plaintiff proceeded with the trial in the usual manner *without in any manner objecting* to the short notice or to his inability to secure witnesses or to his lack of time to prepare for the trial. As a matter of fact plaintiff's counsel had subpoenaed two witnesses here in San Francisco who testified in plaintiff's behalf, and Barili himself testified.

Plaintiff contends in his "statement of points," (R. 36) that he did not have sufficient time to secure evidence of his damages, but this is not correct since the case had been pending for almost five months before the trial on March 10, 1947. *No request was made during the trial for a postponement or for additional time to secure other evidence.* Apparently plaintiff was fully satisfied with his proofs.

It is the contention of these defendants-appellants that it would be impossible for plaintiff to prove damages in this case for the reason that neither defendants made or commercially used a machine of the character covered by plaintiff's patent within the six year period just prior to the filing of the complaint. (R. 99.) The statute of limitations would obviously bar any recovery of damages or profits from defendants under these circumstances.

As to Point 3 with respect to the failure of the Court to award attorney's fees, it is of course within the discretion of the court to award counsel fees to a prevailing party (*Fisher v. Karl*, 6 F.R.D. 268); but the empowering act (Patent Statute 35 U.S.C.A. § 70, as amended Aug. 1, 1946, Public Law 587 of the 79th Congress, Chapter 726) does not compel the Court to award attorney fees to the prevailing party.

**ANSWERING THE OPENING BRIEF OF  
PLAINTIFF-APPELLANT.**

Certain statements made in plaintiff's opening brief are vague and misleading. Under the heading *Point 1*, there is a statement to the effect that plaintiff was not prepared to try the case on its merits or to prove at the trial his damages. There is nothing in the record supporting these statements. The trial of the case proceeded as scheduled and no request was made before, during or after the trial for additional time for submitting proof of damages.

As to *Point 2*, plaintiff is entirely wrong in his contention that the lower court was in error in not assessing damages against defendants. There is no proof whatsoever that plaintiff has suffered damages by reason of any alleged infringing acts of defendants. In fact the evidence is unmistakably clear that no machines of the kind disclosed by the patent in suit were made or used within the six year period preceding the filing of this action. (R. 99.) The lower court, in view of the testimony of Bianchi and the total absence of any evidence proving damages within the six year period prior to the filing of the complaint, could not have allowed damages. (35 U.S.C.A. § 70; *Pollen v. Ford Instrument Co., Inc.*, 108 F. (2d) 762, 763; *Peters v. Hanger*, 134 F. 586.) The case of *Garretson v. Clark*, 111 U.S. 120, is directly in point since the evidence is wholly insufficient to prove damages.

As to *Point 3* it should be noted that various references to the record made by plaintiff under this heading are somewhat inaccurate and misleading. For in-



stance reference is made to pages 97-99, 102, 66-67 and 88-92 of the record with the implication that defendant Marlo Packing Corporation used the "machine (Defendants' Exhibit B) for at least a year at great profit." The testimony of the witnesses recorded on these pages do not support the statement that the machine was used a year or that any profit whatsoever was made by Marlo. Since the evidence is wholly insufficient to prove damages, the lower court was entirely correct in not allowing damages.

Plaintiff-appellant's appeal is frivolous and should be dismissed with costs assessed against him.

Dated, San Francisco, California,

January 9, 1948.

Respectfully submitted,

J. E. TRABUCCO,

*Attorney for Defendants-Appellants.*

